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10/807,844	03/24/2004	Thomas Paul Dunton	135643-2	5475

7590

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EXAMINER

CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/807,844

Applicant(s)

DUNTON ET AL

Examiner

Vivian Chen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3-2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Claim Objections

1. Claims 13-14 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-9, 11-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to define or indicate what constitutes a "class "A" finish".

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, the phrase "a high quality finish appearance" is a vague and indefinite because "high quality" is a relative term which is not adequately defined or specified.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

(a) claims 1-68 of U.S. Patent No. 6,306,507; or

(b) claims 1-75 of U.S. Patent No. 6,610,409; or

(c) claims 1-64 of U.S. Patent No. 6,689,474;

in view of BRUNELLE ET AL (2002/0039657),

and in view WO 02/094560 (hereinafter WO '560),

and in view of MACGREGOR ET AL (US 6,136,441).

The above patents claim multilayer articles comprising a resorcinol arylate polyester surface layer, an intermediate layer, and a substrate layer, wherein the substrate and intermediate layers optionally contain colorants and fillers, and wherein the substrate comprises polycarbonate. However, the above patents do not explicitly claim the recited method of forming a shaped composite.

BRUNELLE ET AL '657 discloses that it is well known in the art to use polycarbonates in both the intermediate layer and substrate layer of a multilayer laminate comprising a clear resorcinol arylate polyester surface layer, an intermediate layer, said multilayer laminate being bonded to a substrate layer containing fibrous fillers. The laminate film can be applied to both surfaces of the substrate. (paragraphs 0090-0118, especially 0109-0110)

WO '560 discloses that it is well known in the art to form multilayer shaped laminates comprising thermoforming a laminate film comprising two or more layers comprising a skin layer and bond-promoting intermediate layers, followed by molding a substrate material against the bond-promoting layers of the thermoformed laminate film so that the intermediate layer(s) bond to the substrate material to form an economical multilayer article with superior environmental and weather resistance. (pages 7-8, 13, 15-17)

MACGREGOR ET AL discloses that it is well known in the art to use known methods such as compression molding to form a substrate resin against a preformed polyester skin layer to produce multilayer laminate articles. (line 40-58, col. 10).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use conventional molding methods such as hot press or compression

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molding to form a substrate material against a thermoformed laminate comprising a resorcinol arylate polyester surface layer. Regarding claims 11-14, the method of forming and molding are product-by-process limitations and is not further limiting in as so far as the structure of the product is concerned. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. *The patentability of a product does not depend on its method of production.* If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." [emphasis added] *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing substantially identical is found, the burden shifts to applicant to show a *unobvious* difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993). One of ordinary skill in the art would have selected the composition of the intermediate layer and molding conditions in order to obtain the interlayer adhesion properties (claims 12-14) required by specific applications.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

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- (a) BRUNELLE ET AL (US 6,307,507); or
 - (b) WO 00/69945 (hereinafter WO '945); or
 - (c) BRUNELLE ET AL (US 6,265,522); or
 - (d) BRUNELLE ET AL (US 6,291,589); or
 - (e) BRUNELLE ET AL (US 6,294,647); or
 - (f) BRUNELLE ET AL (US 2002/0039657); or
 - (g) SHAKHNOVICH (US 6,410,620); or
 - (h) SURIANO ET AL (US 6,528,065);
- in view WO 02/094560 (hereinafter WO '560),
- and in view of MACGREGOR ET AL (US 6,136,441).

The above references (a)-(h) each disclose multilayer articles comprising a laminate film comprising a clear resorcinol arylate polyester surface layer and an intermediate layer, wherein the laminate film is bonded to a substrate layer, wherein the laminate film can be applied to both surfaces of the substrate layer, and wherein the substrate and intermediate layers optionally contain colorants and fibrous fillers, and wherein both the intermediate layer and the substrate comprises polycarbonate. (BRUNELLE ET AL '507, entire document, especially line 20-45, col. 3; line 55, col. 17 to line 20, col. 19; line 62, col. 19, line 13, col. 20; line 51-65, col. 20; line 8-55, col. 21) (see corresponding portions of the other references) However, the above patents do not explicitly claim the recited method of forming a shaped composite using thermoforming.

WO '560 discloses that it is well known in the art to form multilayer shaped laminates comprising thermoforming a laminate film comprising two or more layers comprising a skin layer and bond-promoting intermediate layers, followed by molding a substrate material against

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the bond-promoting layers of the thermoformed laminate film so that the intermediate layer(s) bond to the substrate material to form an economical multilayer article with superior environmental and weather resistance. (pages 7-8, 13, 15-17)

MACGREGOR ET AL discloses that it is well known in the art to use known molding methods such as compression molding to form a substrate resin against a preformed polyester skin layer to produce multilayer laminate articles. (line 40-58, col. 10).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use conventional molding methods such as hot press or compression molding to form a substrate material against a thermoformed laminate comprising a resorcinol arylate polyester surface layer and intermediate layers. Regarding claims 11-14, the method of forming and molding are product-by-process limitations and is not further limiting in as so far as the structure of the product is concerned. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. ***The patentability of a product does not depend on its method of production.*** If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." [emphasis added] *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing substantially identical is found, the burden shifts to applicant to show a ***unobvious*** difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993). One of ordinary skill in the art would have selected the composition of the intermediate layer and molding conditions in order to obtain the interlayer adhesion properties (claims 12-14) required by specific applications.

Conclusion


1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 15, 2005


Vivian Chen
Primary Examiner
Art Unit 1773